

The Examiner has now required restriction between the species drawn to (i) hydroxy-functional polyester diols of claims 6, 7, 12, 19, 20, 26, and 30 and (ii) the fatty alkyl capped complex polyesters of claims 8, 9, 12, 21, 22, 26, and 31¹. The Applicants hereby elect to prosecute the hydroxy-functional polyester diols of claims 6, 7, 12, 19, 20, 26, and 30.

REMARKS

Claims 1-5, 10-18, 23-25, and 27-29 were rejected under 35 USC 103(a) as being unpatentable over Luu et al. (U.S. Pat. No. 5,871,763) in view of Mackey et al. (U.S. Pat. No. 5,705,164). The Applicants respectfully submit that the rejection is improper and submit the following remarks.

By way of background, some tissue products of the prior art have used organic acids for killing viruses. However, these products suffered from the problem that the organic acids tended to cause irritation to the user's skin. The present invention solved this problem of the prior art by combining organic acids with an emollient or topical delivery system which includes at least one polyester. The topical delivery system of the present invention unexpectedly reduces the irritation to the user's skin caused by the use of organic acids.

As recognized by the Examiner, neither Luu et al. or Mackey et al. disclose a tissue product or composition including both an organic acid and an emollient or topical delivery system including at least one polyester. While Luu et al. does in passing mention a few organic acids as optional ingredients, the references are primarily directed to the very specific lotions used in their respective tissue products.

Significantly, the primary objective of Luu et al. is to provide a lotion that has a "non-greasy feeling." See col. 3, lines 48-51. This is accomplished by preparing the lotion from relatively higher melting point components that are *solids* on the tissue product, which then melt upon contact with body heat to facilitate the transfer of the lotion to the surface of the user's skin. Furthermore, Luu et al. preferably uses a lotion that has a relatively high melting point such that the lotion may *resolidify* on the skin.

¹ It is assumed that the Examiner intended to include claim 31 with the group of fatty alkyl capped complex polyesters.

See col. 3, lines 61-65. Luu et al. teaches that lotions that have an onset of melting up to 28°C have the perception of a greasy feel, whereas those that begin to melt only at 31°C to 36°C have a non-greasy feel. See col. 16, lines 50-59.

In stark contrast, Mackey et al., as its title clearly states, is drawn to a lotion having a *liquid* polyol polyester. The lotions of Mackey et al. preferably are semisolids and exhibit fluid-like rheology fluid properties at temperatures only of 20°C. See col. 8, lines 26-32. Accordingly, the *liquid* polyol polyesters of Mackey et al. are exactly the type of component that Luu et al. is trying to avoid.

To establish a prima facie case of obviousness, the Examiner must provide some motivation to combine the prior art references. In the present case, the Examiner has not offered any motivation to combine the teachings of Luu et al. and Mackey et al. Furthermore, it is well established that there can be no motivation to combine where the proposed modification would destroy the intended function of the primary reference. See *In re Fritch*, 972 F.2d 1260, 1265 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992) ("A proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose"); see also *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959) (holding the suggested combination was improper under 35 USC 103 because it would require "a change in the basic principles under which [that reference's] construction was designed to operate"). See also *In re Gordon*, 733 F.2d 900, 902, 221 USPQ2d 11251127 (Fed. Cir. 1981); *In re Haruna*, 249 F.3d 1327, 58 USPQ2d 1517 (Fed. Cir. 2001). In the present case, the combination suggested by the Examiner - the substitution of the *liquid* polyol polyester of Mackey et al. for the non-greasy, high melting point lotion of Luu et al.- would destroy the intended function of the lotion of Luu et al. Accordingly, the Applicants respectfully submit that the rejection is in error and request that it be withdrawn.

CONCLUSION

For the foregoing reasons, the application is now in condition for allowance, and that action is earnestly solicited. Should the examiner feel an interview would expedite

prosecution of this application, the examiner is invited to contact applicant's attorney at the number below.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Robert N. Carpenter", is written over a horizontal line.

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